

REMARKS

This application has been reviewed in light of the Office Action mailed on August 30, 2004. Claims 1 to 13 are pending. No amendments are provided with this response.

Claim Rejections - 35 U.S.C. §103

Claims 1 to 13 stand rejected under 35 U.S.C. §103 (a) as being allegedly unpatentable over Campbell et al. U.S. Patent No. 6,182,469. The Examiner contends that the Campbell patent appears to meet the limitations of the rejected claims and that it is not clear how the claimed processes differ from the process disclosed in Campbell.

Campbell Should Be Regarded Under 35 U.S.C. §103(c)

The claims of the present application are distinct from the processes disclosed in the Campbell patent. Moreover, the Campbell patent issued on February 6, 2001 on application Serial No. 09/439,508 which was filed on November 12, 1999 and which claimed priority to provisional application No. 60/110,502 filed on December 1, 1998. The instant application was filed on October 26, 2001 and is a continuation application of application Serial No. 09/677,220 filed on October 2, 2000 pursuant to 35 U.S.C. §120. The application on which the Campbell patent issued, Serial No. 09/439,508, is mentioned on page 2, at line 27 of the instant application. Accordingly, the application on which the Campbell patent issued was pending during the pendency of the parent of the present application and should not be considered prior art under 35 U.S.C. §103(a).

35 U.S.C. §103(c) provides that:

subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability

under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The instant application and the Campbell patent are both owned by the same corporate person, ElkCorp. Both the instant application and the Campbell patent were initially assigned to Elcor Corporation. The company changed its name, and now the instant application and the Campbell patent are both assigned to ElkCorp as reflected by the two April 8, 2003 United States Patent and Trademark Office Notices of Recordation of Assignment document which are attached to the Terminal Disclaimer submitted herewith.

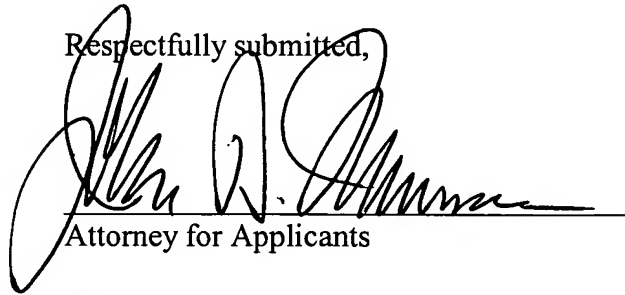
37 C.F.R. 1.130(b) provides that:

when an application or a patent under re-examination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or different inventive entity, a double patenting rejection will be made in the application or a patent under re-examination. A judicially created double patenting rejection may be obviated by filing a Terminal Disclaimer in accordance with §1.321(c).

Applicants provide herewith a Terminal Disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full term of the prior Campbell patent, U.S. Patent No. 6,182,469 B1.

In view of the foregoing remarks and the Terminal Disclaimer submitted herewith, the Applicants submit that the present invention should be deemed patentable. Accordingly, favorable reconsideration of the application is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John D. Murnane", is written over a horizontal line. The signature is fluid and cursive.

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